

REMARKS/ARGUMENTS

The Examiner states that claims 1-19 are presented for examination. The Examiner states claims 6-10 and 16-19 are withdrawn from further consideration by the amendment filed on 9/20/04, as being drawn to a non-elected invention. The Examiner has rejected claims 1-5 and 11-15. Applicant respectfully requests reconsideration of pending claims 1-5 and 11-15.

The Examiner has rejected claims 1-5 and 11-15 under 35 U.S.C. § 102(b) as being anticipated by Oki (Oki), U.S. Patent No. 5,870,595. Applicant respectfully disagrees.

Regarding claim 1, the Examiner has changed the rejection from the previous Office action, in which the Examiner alleged element 81 of Figure 1 of Oki discloses "an activity latch," to presently alleging element 66 of Figure 2 of Oki discloses "an activity latch." In support of the Examiner's assertion, the Examiner purports to quote the following from Oki, citing only col. 5, lines 8-29, "signal 54 is generated based on an value detected by detecting unit 66, and output to an AND logic circuit 83 to control an output of a clock signal 6." However, Applicant has exhaustively searched the entire Oki reference and is unable to locate such text. Rather, Applicant can find only four references to available-area detecting unit 66 in the entire document. Those four references are found in col. 4, line 67, through col. 5, line 3; col., 5, lines 8-12; col. 6, lines 39-42; and col. 6, lines 42-47. The functionality of available-area detecting unit 66 is described therein using the words "detecting," "detected," and "detects." Applicant can find no teaching in Oki of available-area detecting unit 66 being "an activity latch for holding an activity flag value." Thus, Applicant submits that Oki fails to disclose the claimed invention as set forth in claim 1. Therefore, Applicant submits that claim 1 is in condition for allowance.

Regarding claim 2, Applicant notes that the Examiner still cites elements 81a and 81b of Figure 8 of Oki as disclosing a "second activity latch," as the Examiner did in the previous Office action, despite the fact that the Examiner has changed the rejection of claim 1 so as not to cite element 81 of Figure 1 of Oki as allegedly teaching "an activity latch." As noted above, Applicant submits available-area detecting unit 66 of Oki does not disclose "an activity latch." Moreover, as noted previously, Applicant submits that neither AND gate 81a nor AND gate 81b of Oki discloses "an activity latch." Thus, not only does Oki fail to disclose "an activity latch," but Oki also fails to disclose "a second activity latch of a second line card circuit." Moreover, Applicant notes that none of the teachings of

Oki, column 11, lines 56-61, cited by the Examiner appear to disclose the feature of claim 2 “wherein the activity flag value is mutually exclusive with a second activity flag value.” Thus, Applicant submits that claim 2 is in condition for allowance.

Regarding claim 3, as noted above, Applicant submits that Oki fails to disclose the features of claim 1 from which claim 3 depends. Moreover, Applicant submits that Oki fails to disclose an “activity flag value” consonant with the claimed invention. Thus, Applicant submits that claim 3 is also in condition for allowance.

Regarding claim 4, as noted above, Applicant submits that Oki fails to disclose the features of claim 1 from which claim 4 depends. Moreover, Applicant submits that Oki fails to disclose an “activity flag value” consonant with the claimed invention. Thus, Applicant submits that claim 4 is also in condition for allowance.

Regarding claim 5, as noted above, Applicant submits that Oki fails to disclose the features of claim 1 from which claim 5 depends. Moreover, Applicant submits that Oki fails to disclose an “activity flag value” consonant with the claimed invention. Thus, Applicant submits that claim 5 is also in condition for allowance.

Regarding claims 11-15, as noted above, Applicant submits that Oki fails to disclose a “first activity latch” as set forth in claim 11. Thus, Applicant submits that claim 11 is in condition for allowance. As to claim 12, Applicant submits that Oki fails to disclose either a “first activity latch” or a “second activity latch.” Moreover, Applicant notes that none of the teachings of Oki, column 11, lines 56-61, cited by the Examiner appear to disclose the feature of claim 12 “the second activity flag value being mutually exclusive of the first activity flag value.” Thus, Applicant submits that claim 12 is in condition for allowance. Regarding claims 13-15, as noted above, Applicant submits that Oki fails to disclose the features of claim 11 from which claims 13-15 depend. Moreover, Applicant submits that Oki fails to disclose a “first activity flag value” consonant with the claimed invention. Thus, Applicant submits that claims 13-15 are also in condition for allowance.

The Examiner has rejected claims 1, 3-5, 11, and 13-15 under 35 U.S.C. § 102(b) as being anticipated by Karibe et al. (Karibe), JP Patent No. 64-48142. Applicant respectfully disagrees.

Regarding claim 1, the Examiner alleges that counter 5 of Figure 1 of Karibe discloses “an activity latch for holding an activity flag value.” However, Applicant submits that counter 5 of

Karibe's "Address Compare Stop Control System" fails to disclose "an activity latch" of a "line card circuit," as set forth in claim 1. Thus, Applicant submits that Karibe fails to disclose the subject matter of claim 1. Therefore, Applicant submits that claim 1 is in condition for allowance.

Regarding claim 3, the Examiner alleges that Karibe discloses the logic element passes the incoming clock signal as the outgoing clock signal when the activity flag value has a first value. The Examiner purports to quote Karibe as stating, "has a not ZERO value," but Applicant is unable to locate such text in Karibe. Thus, Applicant submits that Karibe fails to disclose the teaching attributed by the Examiner. Therefore, Applicant submits that claim 3 is in condition for allowance.

Regarding claim 4, the Examiner alleges that Karibe discloses the logic element blocks the incoming clock signal when the activity flag value has a second value. The Examiner purports to quote Karibe as stating, "has a ZERO value," but Applicant is unable to locate such text in Karibe. Thus, Applicant submits that Karibe fails to disclose the teaching attributed by the Examiner. Therefore, Applicant submits that claim 4 is in condition for allowance.

Regarding claim 5, the Examiner alleges that Karibe inherently discloses the logic element provides a static output level as the output clock signal when the activity flag value has the second value. While the Examiner asserts a rejection based on inherency, Applicant submits the Examiner has not complied with MPEP § 2112 (Requirements of Rejection Based on Inherency). For example, Applicant submits that the Examiner has not provided a rationale or evidence tending to show inherency, pursuant to MPEP § 2112 IV.

Furthermore, Applicant submits that the teachings of the cited reference fail to establish inherency in accordance with existing law. For example, Applicant submits that the Examiner has failed to establish that the public gained the benefit of the subject matter recited in claim 5 from the teachings of the cited reference. *Schering Corp. v. Geneva Pharmaceuticals*, 339 F.3d 1373 (Fed. Cir. 2003). As another example, Applicant submits that the Examiner has failed to establish that the subject matter recited in claim 5 is present in the teachings of the cited reference. *Mentor v. Medical Device Alliance*, 244 F.3d 1365 (Fed. Cir. 2001); *Scaltech v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999). Thus, Applicant submits that the subject matter recited in claim 5 cannot be considered to be inherent in the teachings of the cited reference. Therefore, Applicant submits that the Examiner has not shown claim 5 to be anticipated by the cited reference. Consequently, Applicant submits that claim 5 is in condition for allowance.

Regarding claims 11 and 13-15, the Examiner states, "basically are the operating step that are carried out by corresponding elements in claims 1 and 3-5," and rejects claims 11 and 13-15 "for the same reason as set forth in claims 1 and 3-5." Applicant has presented above arguments as to why claims 1 and 3-5 are allowable. As the Examiner does not raise any other bases for rejection of claims 11 and 13-15 besides those raised with respect to claims 1 and 3-5, Applicant reiterates Applicant's above arguments to whatever extent they may be applicable to claims 11 and 13-15. Thus, Applicant submits that claims 11 and 13-15 are in condition for allowance.

In conclusion, Applicant has overcome all of the Office's rejections, and early notice of allowance to this effect is earnestly solicited. If, for any reason, the Office is unable to allow the Application on the next Office Action, and believes a telephone interview would be helpful, the Examiner is respectfully requested to contact the undersigned attorney.

Respectfully submitted,

03/15/2005

Date



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